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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/500,947	01/20/2005	Alan J. Fawcett	086310-000000US	1167
20350	7590	10/24/2005	EXAMINER	
TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			FERGUSON, MARISSA L	
			ART UNIT	PAPER NUMBER
			2854	

DATE MAILED: 10/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/500,947

Applicant(s)

FAWCETT ET AL

Examiner

Marissa L. Ferguson

Art Unit

2854

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 10-12 is/are rejected.
- 7) ☒ Claim(s) 6-9 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 July 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 1/20/05
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION *Claim Rejections* - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1,2,4,5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fawcett et al. (US Patent 5,904,096) in view of Minnesota Mining and Manufacturing Company (GB Patent 1,553,431).

Regarding claims 1,2 and 4, Fawcett et al. teaches a plate steel back (14) to be secured to the machine and a metal impression layer (12) consisting of a photopolymer plate secured to the steel back and to engage a substrate (obvious since the method performed by the holding device is foil stamping) to impart an image thereto upon pressure being applied to the die plate and substrate by the machine. However he does not explicitly disclose a compressible adhesive layer that secures an image layer to a steel back. Minnesota Mining and Manufacturing Company teaches a letter press with a compressible mounting material adhesive layer (layer 11 consists on mount 10 that is in combination with layers 20-22 and 24) that consists of an acrylic polymer (referring to polyacrylonitrile on Page 3, Line 33) and a phenolic based resin (Page 3, Lines 50-59) for securing a steel back.

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the invention taught by Fawcett et al. to include

the adhesive layer between the photopolymer plate and steel backing as taught by Minnesota Mining and Manufacturing Company, since Minnesota Mining and Manufacturing Company teaches that it is advantageous to have a compressible surface in order to compensate for adjustments between the plate surface and paper to thereby produce a sharp clean image without distortions.

Regarding claim 5, Fawcett et al. teaches an impression layer formed of brass, steel, copper, zinc, magnesium, aluminum or photo-polymer (12).

2. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fawcett et al. (US Patent 5,904,096) in view of Minnesota Mining and Manufacturing Company (GB Patent 1,553,431) as applied to claim 1 above, further in view of Procknow et al. (EP 0,235,677).

Regarding claim 3, Fawcett et al. and Minnesota Mining and Manufacturing Company both teach the claimed invention with the exception of an adhesive that is an epoxy resin. Procknow et al. teaches an interface epoxy material (Column 4, Lines 34-37) provided between a top steel back surface and base layer. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to further modify the invention taught by Fawcett et al. to replace the adhesive thereof with an epoxy resin adhesive as taught by Procknow et al., since Procknow et al. teaches that is advantageous to provide a strong bonding material for forming a more reliable plate surface.

3. Claims 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fawcett et al. (US Patent 5,904,096) in view of Minnesota Mining and Manufacturing

Company (GB Patent 1,553,431) as applied to claim 1 above, further in view of Marbach (US Patent 4,256,026).

Fawcett et al. and Minnesota Mining and Manufacturing Company both teach the claimed invention with the exception of a die plate thickness of about 0.25mm to about 1 mm. Marbach teaches a stamping device with a die plate (2) with a thickness less than 1mm (Claims 2 and 7 on pages 4 and 5). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to further modify the invention taught by Fawcett et al. to replace the die plate thereof with a die plate with a thickness of 1mm and less as taught by Marbach, since Marbach teaches that is advantageous to provide a smaller thickness in order to maintain close contact thereby providing a clean sharper image.

Allowable Subject Matter

4. Claims 6-9 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: Regarding claim 6, the prior art does not teach or render obvious wherein a die plate has iron embedded in the adhesive.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marissa L. Ferguson whose telephone number is (571)


272-2163. The examiner can normally be reached on (M-T) 6:30am-4:00pm and every other (F) 7:30am-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Hirshfeld can be reached on (571) 272-2168. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Marissa L Ferguson
Examiner
Art Unit 2854

MLF



ANDREW H. HIRSHFELD
SUPERVISORY PATENT EXAMINER
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